

consideration. By this amendment, Applicant is canceling claims 24, 26-33 and 64 without prejudice or disclaimer. Claim 1 has been amended. Claims 85-90 have been added. The claim amendments and new claims are supported in the specification. No new matter has been added. Claims 1-23 and 65-90 are pending for examination with claims 1 and 8 being independent claims.

Summary of Telephone Conference with Examiner

Applicant thanks the Examiner for courtesies extended in a telephone conference on May 2, 2003 between the Examiner and Robert H. Walat, Attorney for Applicant. The claim rejections and cited references were discussed. Applicant is responding to the Office Action as discussed in the telephone conference.

Rejection of Claims 28 and 29 Under 35 U.S.C. §102(b)

The Office Action rejected claims 28 and 29 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,456,976 (LaMarca).

Without acceding to the correctness of this rejection, Applicant has cancelled claims 28 and 29. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Rejection of Claims 1-3, 5-7, 12, 13, 20-24 and 27-29 Under 35 U.S.C. §102(b)/§103(a)

The Office Action rejected claims 1-3, 5-7, 12, 13, 20-24 and 27-29 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,851,617 (Keiser).

Without acceding to the correctness of this rejection, Applicant has amended claim 1 to include the limitation of dependent claim 64, which does not stand rejected on this ground, that the substrate is adhered to a surface of the microcellular polymeric material in the absence of an external adhesive. Keiser fails to teach or suggest an article as recited in amended independent claim 1. Claims 2-3, 5-7, 12, 13 and 20-23 depend from claim 1 and are patentable over Keiser for at least this reason. Claims 24 and 27-29 have been cancelled.

Accordingly, Applicant respectfully requests withdrawal of the rejection on this ground.

Rejection of Claims 4, 9-11, 14-16, 17-19, 26 and 30-33 Under 35 U.S.C. §103(a)

The Office Action rejected claims 4, 9-11, 14-16, 17-19, 26 and 30-33 under 35 U.S.C. §103(a) as being unpatentable over Keiser.

As described above, independent claim 1 has been amended to distinguish over Keiser. Claims 4, 9-11, 14-16 and 17-19 depend from claim 1 and are also patentable over Keiser for at least the reason that claim 1 is patentable over Keiser described above. Claims 26 and 30-33 have been cancelled. Accordingly, Applicant respectfully requests withdrawal of the rejection on this ground.

Rejection of Claim 5 Under 35 U.S.C. §103(a)

The Office Action rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Keiser in view of U.S. Patent No. 4,961,983 (Smorada).

Claim 5 depends from claim 1 which distinguishes over Keiser for the reasons discussed above. Smorada fails to provide the deficiency of Keiser with respect to claim 1. Therefore, claim 5 is patentable over the combination of Keiser in view of Smorada for at least the reason that claim 1 is patentable over Keiser described above. Accordingly, Applicant respectfully requests withdrawal of the rejection on this ground.

Rejection of Claims 1, 2, 6-21, 23, 24, 27, 31-33, 64, 65, 68-82 and 84 Under 35 U.S.C. §103(a)

The Office Action rejected claims 1, 2, 6-21, 23, 24, 27, 31-33, 64, 65, 68-82 and 84 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,235,380 (Tupil patent).

The present application was filed after November 29, 1999. The Tupil patent and the claimed invention were, at the time the invention was made, owned by Trexel Inc., or subject to an obligation of assignment to Trexel Inc. Therefore, the Tupil patent may not be properly be used to reject claims of the present application under 35 U.S.C. §103.

As discussed in the telephone conference, Applicant is filing herewith an Information Disclosure Statement to make of record International Publication No. WO 99/04968 (Tupil PCT Application), which is the publication of the PCT application that corresponds to the Tupil

patent. Therefore, Applicant is addressing the rejection over the Tupil patent with respect to the Tupil PCT Application.

As discussed in the telephone conference, the Tupil PCT application fails to teach or suggest the article recited in amended claim 1 that comprises an injection-molded microcellular polymeric material having a thickness of less than 0.5 inches and a non-planar surface corresponding to a surface of an injection mold cavity. Therefore, claim 1 is patentable over the Tupil PCT application. Claims 2, 6-7, 9-21 and 23 depend from claim 1 and are patentable over the Tupil PCT application for at least this reason.

Furthermore, the Office Action states that the Tupil patent fails to disclose the limitation in independent claim 8 that the article has a curved cross-section. The Office Action also states that this limitation would have been obvious to one of ordinary skill in the art, since no evidence of the record shows the curved cross-section of the article is significant or is anything more than one of numerous shapes.

Applicant respectfully disagrees that the curved cross-section is not significant or is not anything more than one of numerous shapes. Injection molded articles having a curved cross-section represent an important type of article that may be made according to the injection molding methods of the present invention and may be distinguished from the non-injection molded, planar articles (Fig. 7) disclosed in the Tupil PCT application. For at least this reason, Applicant believes the curved cross-section limitation is significant. Therefore, the facts in the present application may be distinguished from the facts in the Dailey case, cited in the Office Action, and this limitation would not have been obvious to one of ordinary skill in the art.

Moreover, Applicant observes no motivation in the Office Action to modify the articles disclosed in the Tupil patent to include a curved cross-section. Therefore, a prima facie case of obviousness has not been met.

Independent claim 8, thus, is patentable over Tupil for at least these reasons. Claims 65-84 depend from claim 8 are also patentable over Tupil.

Accordingly, Applicant respectfully requests withdrawal of the rejection on this ground.

Rejection of Claims 3-5, 22, 26, 66, 67 and 83 Under 35 U.S.C. §103(a)

The Office Action rejected claims 3-5, 22, 26, 66, 67 and 83 under 35 U.S.C. §103(a) as being obvious over Tupil in view of LaMarca. As noted above, the Tupil patent may not be properly be used to reject claims of the present application under 35 U.S.C. §103. However, Applicant is addressing this rejection with respect to the Tupil PCT Application.

Claims 3-5 and 22 depend from claim 1 which, for reasons discussed above, is patentable over the Tupil PCT application. Furthermore, the combination of the Tupil PCT application in view of LaMarca fails to provide the article of claim 1. Therefore, claims 3-5 and 22 are patentable over the combination of the Tupil PCT application in view of LaMarca for at least this reason.

Claims 66, 67 and 83 depend from claim 8, which for reasons discussed above, is patentable over the Tupil PCT application. Furthermore the combination of the Tupil PCT application in view of LaMarca fails to provide the article of claim 8. Therefore, claims 66, 67 and 83 are patentable over the combination of the Tupil PCT application in view of LaMarca for at least this reason.

Claim 26 has been cancelled.

Applicant also respectfully disagrees with the motivation to combine the references as stated in the Office Action and that the claimed fabric thickness would have been obvious to one of ordinary skill in the art.

Accordingly, Applicant respectfully requests withdrawal of the rejection on this ground.

Rejection of Claim 30 Under 35 U.S.C. §103(a)

App The Office Action rejected claim 30 under 35 U.S.C. §103(a) as being obvious over LaMarca.

Without acceding to the correctness of this rejection, Applicant has cancelled claim 30. Accordingly, Applicant respectfully requests withdrawal of the rejection on this ground.

Rejection of Claims 24-26 Under 35 U.S.C. §103(a)

The Office Action rejected claims 24-26 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,629,014 (Kwiatek).

Without acceding to the correctness of this rejection, Applicant has cancelled claims 24-26. Accordingly, Applicant respectfully requests withdrawal of the rejection on this ground.

Double Patenting Rejections

Claims 1, 2, 6-21, 23, 24, 27, 31-33, 64, 65, 68-82 and 84 were rejected under the judicially created doctrine of obviousness type double-patenting as being unpatentable over claims 1-12 of Tupil.

Claims 3-5, 22, 26, 66, 67 and 83 were rejected under the judicially created doctrine of obviousness type double-patenting as being unpatentable over Tupil in view of LaMarca.

Without acceding to the correctness of these rejections, Applicant is filing herewith a Terminal Disclaimer to overcome the rejections.

New Claims

New claims 85-90 depend from either independent claims 1 and 8, which are patentable over the cited references for reasons discussed above. Therefore, new claims 85-90 are also patentable over the cited references for at least these reasons.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee

MARKED-UP CLAIMS

Claims 24, 26-33 and 64 have been canceled without prejudice or disclaimer.

Claims 1 and 8 have been amended as follows:

1. (Three Times Amended) An in-mold decorated article comprising:

an injection-molded microcellular polymeric material having an average cell size of less than 100 microns and a thickness of less than 0.5 inches; and

a substrate adhered to a surface of the microcellular polymeric material in the absence of an external adhesive,

wherein the article [has a curved cross-section] includes a non-planar surface corresponding to a surface of an injection mold cavity.

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occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Joseph P. Vadala, Jr., et al., Applicant



By: _____
Robert H. Walat, Reg. No. 46,324
Timothy J. Oyer, Ph.D., Reg No. 36,628
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2211
Telephone: (617) 720-3500

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